

REMARKS

1) **Summary of Prosecution to Date**

This case was filed on December 29, 2002 with claims 1 – 29.

A requirement for restriction was made on March 22, 2002. A reply to that requirement was made on April 22, 2002. In the reply of April 22, 2002, the applicant traversed the requirement for restriction, and made a provisional election of the claims related to Invention I. In the applicant's view those claims were claims 1 – 18 and 21 – 29. In the Examiner's view those claims were claims 1 – 18 and 27 – 29.

A first office action on the merits was mailed on October 22, 2002. In that office action, the Examiner indicated that he was not persuaded by the applicant's arguments with respect to the claim groupings, and made the election of species requirement "final" with the election of Group I of claims 1 – 18 and 27 – 29.

In addition to a number of formal matters, all of the claims were rejected under either 35 USC 102 or 35 USC 103. In particular:

- (a) Claims 1 – 4, 6, 8, 9, 12, 13, 17 and 18 were rejected under 35 USC 103 as being obvious given US P 4,633,055 of Conley in light of US P 4,103,595 of Corse.
- (b) Claim 5 was rejected under 35 USC 103 given Conley and Corse further in view of US P 6,222,155 of Blackmon et al.
- (c) Claim 7 was rejected under 35 USC 103 given Conley and Corse and further in view of US P 5,787,559 of Dean.
- (d) Claims 10 and 11 were rejected under 35 USC 103 given Conley and Corse, and further in view of US P 3,866,892 of Hooper.
- (e) Claims 27 – 29 were rejected under 35 USC 102 as being anticipated by US P 4,633,055 of Conley.

And, finally, claims 14 and 15 were found to be allowable if re-written in independent form.

In a second Office action, mailed April 1, 2003, the Examiner withdrew the final restriction requirement, but maintained the restriction requirement on the basis that the apparatus of Group I

(claims 1 – 18 and 27 – 29) can be used to another and materially different process to that of Group II (claims 19 – 26).

By this second office action, the Examiner allowed claims 1 to 18 and rejected claims 27 – 29 under 35 USC 103 as being unpatentable over US Patent 4,633,055 of Conley in view of either US Patent 4,070,890 of Stubbings or US Patent 6,315,101 of Hugon. Claims 19 – 26 were withdrawn from consideration.

2) **Claim Objections under 35 U.S.C. 103(a) – Obviousness - Law**

(a) **MPEP Section 2142: Basic Requirements of a *Prima Facie* Case of Obviousness**

Section 2142 of the Manual of Patent Examining Procedure (MPEP) states:

ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant’s disclosure. *In re Vaeck*, 947 F. 2d 488, 20 USPQ2d 1438 (Fed. Cir 1991).

(b) **Mere Possibility of Combination is Not Sufficient**

Section 2143.01 of the Manual of Patent Examining Procedure (MPEP) states:

FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

(c) **Must Have Teaching, Suggestion, or Incentive to Combine**

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention *absent some teaching, suggestion or incentive*

supporting the combination *ACS Hospital Systems Inc. v. Montefiore Hospital*, 732 F. 2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir.). Cited in *In re Geiger*, 815 F.2d at 688, 2 USPQ 2d at 1268 (Fed. Cir. 1987) (Emphasis added). See also *In re Lee*, (61 USPQ 2d 1430 (CAFC, 2002)).

Obviousness cannot be established by combining references without also providing objective evidence of the motivating force that would impel one skilled in the art to do what the patent applicant has done (See *In Re Lee, infra* ; see also *Ex Parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993)).

(d) Inquiry Must Present a Convincing Line of Reasoning

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. “To support the conclusion that the claimed invention is directed toward obvious subject matter, either the references must expressly or impliedly, suggest the claimed invention or *the examiner must present a convincing line of reasoning* as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex Parte Clapp*, 227 USPQ972, 973 (Bd. Pat. App. & Inter. 1985) (Emphasis added).

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex Parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). ”

(e) Inquiry Must Be Thorough And Searching

“The factual enquiry whether to combine the references must be thorough and searching. Id., It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. . . .

“The need for specificity pervades this authority. See e.g.,

“*In re Kotzab* 217 F. 3d 1365, 1371, 55 USPQ 2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”);

In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ 2d 1453, 1459 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art

would have been motivated to select the references and to combine them to render the claimed invention obvious.”);

In re Fritch, 972 F. 2d 1260, 1265, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) (The examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”).”

(*In re Lee*, 61 USPQ 2d 1430 (CAFC, 2002). Emphasis and paragraph division added.)

Conclusory statements by an examiner do not adequately address the issue of motivation to combine. (*In re Lee, supra*).

(f) “Would have been obvious to one skilled in the art”

The MPEP requires that the examiner provide an objective source of support for a contention that a feature is known or obvious to one skilled in the art. An unsupported statement that a feature or combination “would have been obvious to one skilled in the art” is improper if made without support. *In re Lee, supra*, and *In re Garrett* 33 BNA PTCJ 43.

A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made because references relied upon teach that all aspects of the claimed invention were individually known in the art” is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ 2d 1300 (Bd. Pat. App. & Inter. 1993). See also *Al-site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide suggestion to combine references).

3) Claims 27 to 29

The Examiner has rejected claims 27 to 29 under 35 USC 103 as being unpatentable over US Patent 4,633,055 of Conley in view of either US Patent 4,070,890 of Stubbings or US Patent 6,315,101 of Hugon.

According to the Examiner, Conley shows all the features of claim 27, except a path defining a circuit about which said movable bed can move. Further, the examiner is of the opinion that Stubbings and Hugon disclose an apparatus for cutting sheet (sic) of metal having a

path defining a circuit about which said moveable bed can move. The Examiner has cited Figure 1 and column 6, lines 4-6 of Stubbings and Figure 1 and column 4, lines 25-28 of Hugon to support the rejection. According to the Examiner, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize in Conley a path defining a circuit about which said moveable bed can move as taught by Stubbings and Hugon in order to simplifying (sic) the apparatus of conveyor transfer systems.

The applicant respectfully traverses this rejection.

i) US Patent 4,070,890 of Stubbings

Stubbings discloses a method and apparatus for cutting sheet metal wrappers. Column 6, lines 4 to 6 of Stubbings read as follows:

- a. conveyor means for continuously feeding a metal sheet into a cutting position, and past said cutting position, in a given direction x,

At column 4, lines 11 to 13, the conveying means (16) preferably comprises one or more conveying belts (70) which are mounted below cutting assemblies 12, 14. This is illustrated in Figure 1, which shows two conveyor belts located adjacent one another, which convey the metal sheet in the x-direction, past cutting assemblies 12, 14, towards notching assemblies 22, 23 and edge deforming means, 24, 25.

To establish a *prima facie* case of obviousness under 35 USC 103 the Examiner is required to demonstrate on the basis of objective evidence of record in this case (a) suggestion, motivation or incentive to combine or modify the references as proposed; and (b) that, when combined, the references will yield the claimed invention.

a) Suggestion, Motivation or Incentive to Combine

The Examiner has not presented, nor, after careful review of the cited references, can the Applicant find, any motivation to combine the references of Conley and Stubbings. According to the Examiner, the use of the moveable bed of Stubbings in the apparatus of Conley would simplify the apparatus of a conveyor transfer system. Applicant finds this statement somewhat curious. Conley's apparatus is not a conveyor transfer system. Conley discloses a rolling table

that moves the metal to be cut from a loading position to a cutting position, and, after cutting, to an off-loading position co-incident with the loading position.

Conley appears to have considered the problem of how to improve the efficiency of operation of his apparatus, and seems to have sought to address the problem by providing a second table 113 (Figure 7) positioned at the end of the table support rail. In this manner, an operator can load the second table while the first table is in the cutting position. Applicant submits that there would be no motivation to add the conveyor of Stubbings to the plasma cutting system of Conley, since Conley has already designed a system to allow simultaneous cutting and loading or unloading. That is, the addition of Stubbings' conveyor to Conley's moving table would seem to be redundant. The applicant does not understand how the addition of an apparently redundant conveyor would simplify Conley's apparatus.

b) Combination must yield invention

It is not clear from the Examiner's commentary whether the Examiner considers Stubbings' conveyor as being a bed or as being a circuit, (or, indeed, as being something else entirely). In that light, it is difficult to see how the Examiner has demonstrated that the proposed combination, even if made, would result in the claimed invention.

In the event that the Examiner proposes to sustain the present rejection under 35 USC 103, the applicant respectfully requests that the Examiner list the parts of Stubbings that are thought to correspond to the elements of the claim, and to provide a full and fair, non-final, opportunity to the applicant in which to respond to such rejection, once the basis of the rejection has been made clear. That is, the applicant would like to provide a full response to the present rejection, but is unable to do so since the basis of the rejection is not presently clear from the Examiner's commentary.

c) Summary Re: Conley in view of Stubbings

Subject to whatever further explanation or clarification by the Examiner, the applicant respectfully submits that (a) there is no suggestion, motivation or incentive to combine Conley and Stubbings, as proposed since it appears to lead to redundant structure; and (b) the interpretation of Stubbings by the Examiner, appears inconsistent with the proposed combination having all of the elements of the claimed invention.

For the reasons given above, the applicant requests that the Examiner withdraw the rejection made under 35 USC 103 in light of Conley in view of Stubbings.

ii) US Patent 6,315,101 of Hugon

Hugon discloses a chain conveyor *for a machine for sorting flat objects* or a *baggage conveyor for use in an airport* (Emphasis added). The conveyor is composed of stretches of chain which are guided in a guide rail. The purpose of the conveyor is to make objects placed on the conveyor continuously available for transfer. Contrary to the Examiner's commentary, there is nothing in Hugon that refers in any way to an apparatus for cutting sheet [sic] of metal.

a) Hugon is in a different field

Hugon is in the wrong field. As discussed above, the chain conveyor of Hugon is designed for a sorting machine or for use in a baggage conveyor. The applicant submits that, contrary to *Clapp* and *Rouffet*, cited above, the Examiner has not demonstrated any reason why a person skilled in the art of designing metal cutting apparatus would look to Hugon's conveyor to arrive at the present invention.

b) Suggestion, Motivation or Incentive to Combine

Applicant submits that the Examiner has not established a *prima facie* case of obviousness. The Examiner has not presented, nor can the Applicant find, any motivation to combine the references of Conley and Hugon.

According to the Examiner, the use of a moveable bed as taught by Hugon in the apparatus of Conley would simplify the apparatus of a conveyor transfer system. Applicant finds this statement somewhat difficult to understand. Conley's apparatus is not a conveyor transfer system. Conley discloses a rolling table which moves the metal to be cut from a loading position to a cutting position and after cutting, to an off-loading position which is co-incident with the loading position.

Conley appears to have considered the problem of how to improve the efficiency of operation of his apparatus and sought to address the problem by providing a second table 113

(Figure 7) positioned at the end of the table support rail. In this manner, an operator can load the second table while the first table is in the cutting position. Applicant submits that there would be no motivation to add the conveyor of Hugon to the plasma cutting system of Conley, since Conley has already designed a system to allow simultaneous cutting and loading or unloading.

Again, the applicant is unable to understand the basis upon which such a combination would "simplify" Conley's apparatus, as is suggested by the Examiner.

In that light, the applicant respectfully submits that no *prima facie* grounds for rejection under 35 USC 103 have been established, requests that the current rejection based on Conley in view of Stubbings be reconsidered, and upon reconsideration, that it be withdrawn, and requests that the claims be allowed.

Conclusion

The applicant respectfully submits that the claims as presently pending are allowable over the cited art. As such the applicant requests early and favourable disposition of this matter.

Respectfully submitted,



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